

### REMARKS

Applicant hereby elects the claims 8-14 identified under Species II along with claims 1-4 and 6-7, which are identified as generic. This election is made with traverse relative to the alleged restriction of the claims of Species I (claim 5) from the claims of Species II.

Applicant respectfully traverses the election of species requirement presented in the instant Office Action because the Examiner fails to present a *prima facie* case for requiring the restriction of Species I and II relative to each other. The Examiner erroneously relies upon international rules (*i.e.*, PCT Rules 13.1 and 13.2) to support the restriction of species. It is unclear to Applicant how PCT Rules are applicable to the prosecution of a US application. Applicant respectfully directs the Examiner to Chapter 800 of the M.P.E.P. and in particular to M.P.E.P. §§ 806.04(b) and 806.05(j), which deal with restriction of species in US applications.

In this instance, the Office Action has not asserted Species I and II are independent or distinct as is required to support the restriction of Species I and II relative to each other. Specifically, the Office Action has not provided any analysis regarding how or why Species I and II are independent (*i.e.*, that these species are not connected in any of design, operation, or effect). *See, e.g.*, M.P.E.P. § 806.04(b). The Office Action also has not provided any analysis regarding how or why Species I and II are distinct. According to M.P.E.P. § 806.05(j), related inventions are “distinct if (A) the inventions *as claimed* do not overlap in scope, *i.e.*, are mutually exclusive; (B) the inventions *as claimed* are not obvious variants; and (C) the inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function, or effect.” In this instance the Office Action has not provided any indication that Species I and II do not overlap in scope, that they are not capable of use together or that these species can have a materially different design, mode of operation, function, or effect as required to show that these species are distinct. Accordingly, the restriction of Species I and II relative to each other is improper and cannot be maintained.

Applicant further notes that the Office Action must provide reasoning to support any assertion that the species are independent or distinct. *See, e.g.*, M.P.E.P. § 808.01 (“The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is


inadequate. The reasons upon which the conclusion is based should be given.”). Moreover, M.P.E.P. § 806.05(j) further requires that “reasons for insisting on restriction are necessary.” See, also M.P.E.P. § 808.02 (“Where the \* inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required.”). Applicant respectfully submits that any assertion that the continued examination of Species I (claim 5) and II (claims 8-14) together would be “a serious burden” on the Examiner would be disingenuous at best because the Examiner has already examined claims 5 and 8-14 together, including issuing two Office Actions on the merits and performing at least two separate prior art searches.

Moreover, new claim 15 provides the already-examined claim set a linking claim for allegedly disparate species I and II. See MPEP§806.05(e) which requires that species that would otherwise be distinct except for the linking claim, must to be examined together.

In view of the above, Applicants respectfully requests that the Examiner withdraw the present restriction requirement for examination of all the claims.

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